

R E M A R K S

Claims 12, 15-18 and 24 are in this application. Claims 13, 14, and 19-23 have been cancelled. Claim 24 which is a combination of claims 21-23 has been added.

The Examiner has stated that Claims 12 and 15-18 are allowed.

According to the Official Action, Claims 13, 14 and 19-23 are rejected as being obvious over Chaudhari et al. (US Patent 5,650,546) in view of Browning et al. (US Patent 3,901,822).

This rejection is respectfully traversed.

The catalyst of this invention is a bimetallic catalyst system (group II metal and Pt or Pd) including a support. This is not disclosed nor suggested in the combination of Chaudhari and Browning.

The disclosure of Chaudhari is not relevant to the claimed invention. Chaudhari discloses a water soluble catalyst wherein the catalyst of this invention is insoluble in the reaction medium. The catalysts of this invention can be separated out by filtration and can be easily used repeatedly. In addition, Chaudhari does not disclose or suggest the use of a Group II metal selected from magnesium, calcium and barium in the catalyst.

According to column 1 of Browning, the invention relates to the regeneration of noble metal hydrogenation catalysts used for producing hydrogen peroxide by the anthraquinone process.

The Examiner refers to the disclosure in col. 2, lines 26-34 and states that "the difference between the presently claimed invention and what is taught by Browning et al. reference is that the Browning et al. reference is silent with regard to the percentage of the noble metal contained in the hydrogenation catalyst."

The disclosure that the examiner refers to is merely a list of noble metals and a statement that the catalyst may be either unsupported on a carrier or supported on a carrier of specific particle size-examples of which are alumina, silica gel, carbon, magnesium carbonate, dolomite and the like. There is no disclosure or suggestion of the use of the acetate, nitrate or chloride salts of magnesium, calcium and barium. There is no suggestion of the use of particular combinations of noble metals and carriers (and as stated above, a carrier is optional). In addition there is no disclosure or suggestion of the use of the possibility of nickel with when B is Pd. The examiner makes the statement that "in [sic] would not be unreasonable for one having ordinary skill in the art to expect that the hydrogenation catalysts taught by Browning et al. would contain noble metal in a percentage of anywhere from 0.2-10%." The examiner has not provided any support for this statement. There is no disclosure or suggestion of how one of ordinary skill in the art would determine the percentages of the carriers, Pt or Pd and nickel of the claimed catalysts.

In addition, none of the catalysts of Claim 24 are disclosed or suggested in the cited references.

The Examiner is relying on impermissible hindsight in making this rejection.

According to MPEP 2141 when applying 35 USC 103, the following tenets of patent law must be adhered to:

(A) The claimed invention must be considered as a whole; (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention and (D) reasonable expectation of success is the standard with which obviousness is determined.

A reference must be considered for what it would teach someone skilled in the art at the time the invention was made and not be applied based on "hindsight". See *Panduit Corp. V. Dennison Manufacturing Co.* 227 USPQ 337, 343 (Fed. Cir. 1985):

It is impermissible to first ascertain factually what applicants did and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct appellants' invention from such prior art.

In making its obviousness determination, a court must view the prior art without reading into that art the patent's teachings. *Vandenberg v. Dairy Equipment*, 224 U.S.P.Q. 195 (Fed. Cir. 1987) citing *In re Sponnoble*, 160 U.S.P.Q. 237 (CCPA 1969). In *Uniroyal . Rudkin-Wiley*, 50 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988) the CAFC stated:

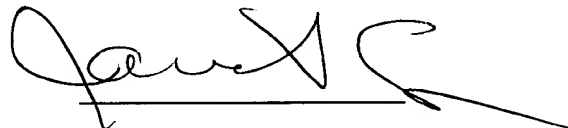
The obviousness standard, while easy to expound, is sometimes difficult to apply. It requires the decision maker to return to the time the invention was made. The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time...That which may be clear and thus obvious to a court, with the invention fully diagramed and aided by experts in the field, may have been a breakthrough of substantial dimension when first unveiled [citations omitted]. In this case we are convinced

that the district court misapplied the obviousness standard. It has impermissibly used hindsight to reconstruct the claimed invention from prior art with the invention before it and aided by Uniroyal's expert, rather than viewing the invention from the position of a person of ordinary skill at the time it was made. When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.

Therefore, since there is no disclosure or suggestion in the combination of the references cited by the examiner and it appears that the examiner is relying on hindsight, it is respectfully requested that the rejection be withdrawn.

It is submitted that the application is in condition for allowance and favorable consideration is respectfully requested.

Respectfully submitted

A handwritten signature in black ink, appearing to read 'Janet I. Cord', is written over a horizontal line. The signature is stylized with a large initial 'J' and a long, sweeping tail.

JANET I. CORD
LADAS & PARRY
26 WEST 61ST STREET
NEW YORK, NEW YORK 10023
REG. NO. 33778
TEL.NO. (212) 708-1935